

SERIAL NO. 10/091,335

DOCKET NO. 1567.1020

REMARKSINTRODUCTION:

In accordance with the foregoing, claims 1, 5, 6, 15, 21, 36, 42, and 45 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-48 are pending and under consideration. Reconsideration is requested.

ENTRY OF AMENDMENT UNDER 37 C.F.R. §1.116:

Applicants request entry of this Rule 116 Response because:

(1) it is believed that the amendment of claims 1, 5, 6, 15, 21, 36, 42, and 45 puts this application into condition for allowance as suggested by the Examiner on page 3 of the Office Action;

(2) the amendments of claims 1, 5, 6, 15, 21, 36, 42, and 45 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and

(3) the amendments do not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

SERIAL NO. 10/091,335**DOCKET NO. 1567.1020****REJECTION UNDER 35 U.S.C. §112:**

In the Office Action at pages 2-3, the Examiner rejects claims 1-40, 42-45, 47, and 48 under 35 U.S.C. §112, second paragraph, as being indefinite with regard to the term "conductive polymeric dispersant." This rejection is respectfully traversed and reconsideration is requested.

While the applicants do not agree that one of ordinary skill in the art would be confused as to the "conductive polymeric dispersant" in light of the factors required to be considered in order to establish a prima facie indefiniteness rejection, it is respectfully submitted that the claims have been amended in accordance with the Examiner's suggestion on page 3 of the Office Action in order to clarify that the conductive polymeric dispersant is at least ionically conductive. As such, it is respectfully submitted that the claims remain compliant with 35 U.S.C. §112, and it is requested that the rejection be reconsidered and withdrawn.

STATUS OF CLAIMS NOT REJECTED IN OFFICE ACTION

On page 2 of the Office Action, the Examiner states that claims 41 and 46 are allowed.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

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If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: Oct. 22, 2004

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted via facsimile to: Commissioner for Patents,
P.O. Box 1450, Alexandria, VA 22313-1450

on Oct. 22, 2004

STAAS & HALSEY

By: James G. McEwen
Date: Oct. 22, 2004